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[REDACTED] EXAMINER

COLE, LAURA C

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1744

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/040,652	ER, POH LEONG
	Examiner Laura C Cole	Art Unit 1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 February 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 October 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.<br>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 6) <input checked="" type="checkbox"/> Other: <i>Exhibits A, B</i> .   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. |  |

## DETAILED ACTION

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Drawings***

2. The drawings are objected to because in Figure 2, it appears that "20" is used inadvertently to point to two different portions of the journal. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The

disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the present application, the abstract is more than one paragraph.

4. The disclosure is objected to because of the following informalities: Page 1 Line 28 there appears to be a number missing in the U.S. Patent number that is listed.

Appropriate correction is required.

### ***Claim Objections***

5. Applicant is advised that should claims 7, 8, 9, 10, 11, or 12 be found allowable, claims 13 (duplicate of 7), 19 (duplicate of 8), 20 (duplicate of 9), 21 (duplicate of 10), 22 (duplicate of 11), or 22 (duplicate of 12) will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

6. Claims 6 and 18 are objected to because of the following informalities:

Both Claims 6 and 18 recite, "...wherein said cylindrical protrusion forms a channel..." It is confusing how a protrusion (a solid portion or material extension) would form a channel that requires an opening or aperture. Is there an opening or hollow portion within the protrusion? Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, 7-10, 13-17, and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Powers, USPN 3,253,290.

Powers discloses a surface treating element that comprises an applicator having a cylindrical outer surface and two ends (1a), two holder mounts (2) having a base surface (the interior surface) and further comprising a journal protruding from the base surface (2) comprising at least one holder abutment and having a planar abutment surface aligned on a common plane (the holder abutment being the portion surrounding (3), but not the spokes extending from it as seen in Figure 3). The total area of the planar abutment surface is smaller than an axial cross-section of each holder mount (as seen best in Figures 1 and 3), wherein the journal further comprises a cylindrical protrusion (3), wherein the at least one abutment forms a ring surrounding the cylindrical protrusions (see above, Figure 3), and wherein the at least one holder abutment forms a plurality of arc shaped members disposed about the protrusion (being the portions of (2) that are defined by (17) and are located at the end of the “spokes” that are farthest away from (3)). Further, Powers discloses an applicator holder having a handle (9) and a fork having opposite sides (6a and 6b), having a journal engagement

portion comprising a loop (3a), the loop comprising a mount abutment surface (the interior portions of the fork loops surrounding (3a)) having an area larger than the total area of planar abutment surface of the journal (as seen in Figures 1 and 2), and wherein the area of the mount abutment surface is smaller than an axial cross section of each holder mount (as seen in Figures 1 and 2).

8. Claims 1, 3-4, 7-8, 13, 15-16, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Jenking, USPN 435,606.

Jenking discloses a roller that comprises a paint applicator (C) having a cylindrical surface and two opposing ends, two holder mounts (F) having a base surface (the interior surface facing the centerline x), each holder mount comprising a journal protruding from the base surface in a direction away from the paint applicator (Figures 1 and 3), each holder abutment having a planar abutment surface on a common plane (the surface of (F) that is the exterior surface facing away from x). Jenking further discloses that the journal further comprises a cylindrical protrusion (f) and that the holder abutment forms a ring surrounding the cylindrical protrusion (Figure 1). Further, Jenking discloses a handle (E) and a fork (D) having opposite sides and a journal engagement portion (see Figure 1) wherein the journal engagement portion comprises a loop (See Figures 1 and 3, (f) is inherently inserted through a loop or hole for attachment).

9. Claims 1, 3-4, 6-8, 11, 13, 15-16, 18-19, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Roux, USPN 596,090.

Roux discloses a roller that comprises a paint applicator (7) having a cylindrical outer surface and two opposite ends and two holder mounts (at 8) having a base surface (interior or inner surface) further comprising a journal protruding from each base surface (8), the journal comprising at least one holder abutment (exterior surface of 8). The journal further comprises a cylindrical protrusion (6), at least one holder abutment forms a ring surrounding the cylindrical protrusion (as seen in Figures 1 and 3), and the protrusion forms a channel with an inner wall having a ridge (see Figures 1 and 3, the hidden lines of (6) showing the channel opening having a ridge as it extends inward of the roller). Further, Roux discloses an applicator holder having a handle (1) and a fork (3) having opposite sides (4), the journal engagement portion inherently comprises a loop for coupling to the journal (Figure 1). The roller further comprises a cover for capping at least one of the holder mounts (12).

10. Claims 1-4, 6-16, and 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Er, USPN 6,036,392.

Er discloses a painting tool that comprises a paint applicator having a cylindrical outer surface and two opposite ends (2), two holder mounts (Exhibit A - Figure 4) , two journals protruding from the base surface and further comprising at least one holder abutment aligned on a common plane (Exhibit A). Er further discloses that the total area of the planar abutment surface for the journal is smaller than an axial cross-section of each of the holder mounts (Exhibit A), wherein the journal further comprises a cylindrical protrusion (Exhibit A), and wherein the cylindrical protrusion forms a channel with an inner wall having at least one circumferential ridge (Exhibit A). Er further

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discloses a handle (12) and fork (7) having opposite sides (8) having a journal engagement portion (inner surface of the opposite sides), the journal engagement portion further comprising a loop (assemblies shown in Figures 1 and 2 make it inherent that the end walls (8) are in a loop shape to engage the cap and roller), the loop comprises a mount abutment surface having an area larger than the planar abutment surface (Exhibit B), the area of the mount abutment surface is smaller than an axial cross section of each of the holder mounts (Exhibits A and B). There is a cover for capping at least one of the holder mounts (6) and comprises a cylindrical portion having at least one perimeter ridge (Figure 2 (6)).

11. Claims 1, 3-4, 7-8, 11-13, 15-16, 19 and 22-23 are rejected under 35

U.S.C. 102(b) as being anticipated by Mallindine, USPN 3,588,264.

Mallindine discloses a paint roller that comprises a paint applicator having a cylindrical outer surface and two opposite ends (20) and two holder mounts (25 and 26) having a base surface (the interior surface) and further comprising a journal protruding from the base (16 and 17) comprising a holder abutment (interior surface of (16) or (17) facing inwards) having a planar abutment surface aligned on a common plane (exterior surface of (16) and (17)). The journal further includes a cylindrical protrusion (14), wherein the one holder abutment forms a ring surrounding the protrusion (Figure 6 either (14) or (18), (18) not being continuous with the piece (17)). The applicator holder has a handle (10) and a fork having opposite sides (12 and 13) having a journal engagement portion (interior surfaces of sides) and a loop (13a and 12a). There is a

cover (18) for capping at least one of the holder mounts having a perimeter ridge (Figure 6 (18)).

12. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kessler, USPN 4,458,399.

Kessler discloses an ink roller that comprises a paint applicator having a cylindrical outer surface and two opposite ends (12), two holder mounts (32) having a base surface (interior surface of (32)) and further comprising a journal protruding from base surface (32) comprising a holder abutment (where leader line (32) is pointing in Figure 1), the holder abutment having a planar abutment surface (located on the "ridge-like" unlabeled circle on (32) in Figure 1). The total area of the planar abutment surface for each journal is smaller than the holder mounts (Figures 1-2), wherein the journal further comprises a cylindrical protrusion (36), wherein the holder abutment forms a ring surrounding the cylindrical protrusion (Figure 1).

13. Claims 1-4, 7-9, 13-16, and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Newman et al., USPN 6,519,800.

Newman et al. disclose a paint roller comprising a paint applicator having a cylindrical outer surface and two opposite ends (16), two holder mounts (Figure 3 where (48) is located) having a base surface (interior surface of the radially largest portion of the object that has (48)) and further comprising a journal protruding from base surface (object where (48) is located) comprising a holder abutment (flat part of the radially largest portion of the object that has (48))), the holder abutment having a planar abutment surface (O-shaped hidden lines adjacent to (48)). The total area of the planar

abutment surface for each of the journals is smaller than the area of the entire holder mount (Figure 1), wherein the journal comprises a cylindrical portion (48), and the holder abutment forms a ring surrounding the cylindrical portion (Figure 3.) Further, the applicator holder comprises a handle (18) and a fork having opposite sides (42 and 58), each of the opposite sides having a journal engagement portion (interior surfaces of the sides (42 and 58)). The journal engagement portion comprises a loop (46 and 62). The loop comprises a mount abutment surface (interior surface of the sides (42 and 58) that has an area larger than the planar abutment surface for each journal (Figure 3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kessler, USPN 4,458,399.

Kessler discloses all elements above, however does not disclose a plurality of arc-shaped members disposed around the cylindrical portion.

It would have been an obvious matter of engineering choice to modify the shape of Kessler to contain arc-shaped members since such a modification would have involved a mere change in the shape or form of a component. A change in shape or form is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1976).

15. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Er, USPN 6,036,392.

Er discloses all elements above, however does not disclose a plurality of arc-shaped members disposed around the cylindrical portion.

It would have been an obvious matter of engineering choice to modify the shape of Kessler to contain arc-shaped members since such a modification would have involved a mere change in the shape or form of a component. A change in shape or form is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1976).

16. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mallindine, USPN 3,588,264 in view of Powers, USPN 3,253,290.

Mallindine and Powers disclose all elements above, however Mallindine does not disclose a plurality of arc-shaped members disposed around the cylindrical portion.

It would have been obvious for one of ordinary skill in the art to modify the holder abutment of Mallindine for one of Powers for ergonomic reasons, decorative purposes, and, provides a greater rolling balance.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 6,098,240 to Taylor, made reference to by Applicant on Page 1 of the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C Cole whose telephone number is (703) 305-7279. The examiner can normally be reached on Monday-Thursday, 7am - 4:30pm, alternating Fridays.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Warden can be reached on (703) 308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8772 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

LCC  
LCC  
August 8, 2003

*Robert J. Warden, Sr.*  
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